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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,498	07/09/2001	David P. Kippie	05542/008002	5182

22511 7590 08/03/2004

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EXAMINER	
TUCKER, PHILIP C	

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/901,498	KIPPIE ET AL.	
	Examiner	Art Unit	
	Philip C Tucker	1712	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,8,17-22,24-26 and 28-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,8,17-22,24-26 and 28-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-6, 8, 25, 26 and 28-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed fails to teach the use of guar gum. This thus represents new matter.

Claims Interpretation

1. In the claims applicant has claimed that the polymer is a viscosifying agent, which is true of the applied prior art polymers which provide viscosity to the fluids. Applicant has taught the amine in an amount effective to prevent substantial decomposition of the natural polymer in the claims. The claims are interpreted in view of case law which indicates that a novel intended use, or discovery of an inherent property cannot impart patentability to an old composition (see In re Pearson 181 USPQ 641, In re Zierden 162 USPQ 102, In re Tomlinsin 150 USPQ 623).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5, 6, 8, 25, 26, 28-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Baranet (4780223).

Baranet teaches a well treatment fluid which comprises triethanolamine amine and a natural polymer (see Examples which teach the use of guar type polymers).

4. Claims 1-6, 8, 25, 26 and 28-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Mitchell (6227295).

Mitchell teaches a well treatment fluid which comprises amines and natural polymers (see examples and tables). Mitchell specifically teaches that the amine stabilizes the polymer (see column 3, lines 27-65 and column 5, lines 35-40). The 0.4% of amine in the table in column 6 would anticipate the about 0.5% of claim 4.

5. Claims 1-6, 8, 25, 26 and 28-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Glass Jr. (4486340).

Glass teaches a fluid which is solids free, and is used in well treatment which comprises a polymer such as hydroxyethyl cellulose, and various amines, such as triethanol amine within the amounts of the present invention (see claim 1, column 11, line 1 – column 13, line 24 and column 10, lines 44-51).

6. Claims 17-22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Herrick (4481076).

Herrick teaches a mixture consisting of cellulose and triethanol amine (see Example 9). The percentages of claims 19-22 are not limiting, since the composition, and not the well fluid, is being claimed.

7. Claims 17-22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Herrick (4481077).

Herrick teaches a mixture consisting of cellulose and triethanol amine (see claim 1 and column 2, line 21). The percentages of claims 19-22 are not limiting, since the composition, and not the well fluid, is being claimed.

8. Applicant's amendment and arguments have been considered but are not deemed fully persuasive with respect to the prior art. Applicants amendment has overcome the Hanlon and Glass '985 rejections, since the specific polymers of the present claims are not taught by Hanlon, and Glass '985 would comprise some solid in the wellbore fluids since the fluids therein comprise bentonite. The use of "consisting of" distinguished from the cited prior art, since other ingredients were contained in the fluids disclosed.

9. Applicant has argued that incorporation of the limitation of claim 7 and 27 into independent claims distinguishes over Baranet. However, applicant has also added guar gum as a part of claims 1 and 25, which is taught by Baranet, and is thus not distinguished. Applicant has argued that the crosslinking agent is the component which increases the viscosity of the composition in the prior art of Baranet and Mitchell.

Although the crosslinking agent does contribute to an increase of the viscosity of the composition, compared to a composition without such crosslinker, it is clearly the polymer which is the viscosity increasing agent, since such increases the viscosity of the composition in the absence of the crosslinking agent, but not vice-versa. In whichever case, it is still the polymer, whether crosslinked or not which viscosifies the composition. As noted in the claims interpretation section a novel intended use, or discovery of an inherent property cannot impart patentability to an old composition (see In re Pearson 181 USPQ 641, In re Zierden 162 USPQ 102, In re Tomlinsin 150 USPQ 623). The intended use of the amine to prevent decomposition of the polymer cannot distinguish over the prior art. The prior art teaches the use of the amine at the same levels as taught in the current claims. Applicant has not given any evidence to show that the polymers of the prior art would not also be subject to less decomposition, as stated in the present claims, when exposed to the same amines, such as triethanolamine, as used in the present invention.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Philip C Tucker
Primary Examiner
Art Unit 1712